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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,106	03/05/2001	David Funk	41938/DBP/C664	2743

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CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

EXAMINER	
SEDIGHIAN, REZA	

ART UNIT	PAPER NUMBER
2633	7

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/800,106	FUNK, DAVID
	Examiner	Art Unit
	M. R. Sedighian	2633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. This communication is responsive to applicant's 4/6/04 amendment in the application of David Funk for "Optical Supervisory Channel" filed 3/5/01. The amendments have been entered. Claims 1-17 are now pending.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-10 and 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 3, it recites the limitation "the management function" in line 2. There is insufficient antecedent basis for this limitation in the claim.

As to claim 4, it recites the limitation "the management function" in line 3. There is insufficient antecedent basis for this limitation in the claim.

As to claim 5, it recites the limitation "the management function" in line 3. There is insufficient antecedent basis for this limitation in the claim.

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 2, 4, 5, 8, 12, and 13 are rejected under 35 U.S.C. 101. because of the term "**in use**". The claimed invention lack patentable utility. The term "**in use**" raises an issue of indefiniteness under 35 U.S.C. 112 second paragraph, and 35 U.S.C. 101. Attempts to claim a

process without setting forth any steps involved in the process generally raises an issue of indefiniteness under 35 U.S.C. 112, second paragraph. For example, a claim which read: "A process for using monoclonal antibodies of claim 4 to isolate and purify human fibroblast interferon." was held to be indefinite because it merely recites a use without any active, positive steps delimiting how this use is actually practiced. Ex parte Erich, 3 USPQ2d 1011 (Bd. Pat. Apo. & Inter. 1986). Other decisions suggest that a more appropriate basis for this type of rejection is 35U.S.C. 101. In Ex parte Dunki, 153 USPQ 678 (Bd. App. 1967), the Board held the following claim to be an improper definition of a process: "The use of a high carbon austenitic iron alloy having a proportion of free carbon as a vehicle brake part subject to stress by sliding friction." In Clinical Products Ltd. v. Brenner, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966), the district court held the following claim was definite, but that it was not a proper process claim under 35 U.S.C. 101: "The use of a sustained release therapeutic agent in the body of ephedrine absorbed upon polystyrene sulfuric acid." Although a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969) and In re Winches, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claim that are not recited in the claim.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 11-14 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Defender (US Patent No: 5,886,801).

Regarding claims 11, 12, and 16, Van Defender teaches a method of managing an optical network (col. 2, lines 20-30 and fig. 1), comprising: sending duplicate OSC signals (col. 4, lines 30-46, note that optical signal DS is distributed by power splitter 2 into two optical signals B and F, furthermore, examiner interprets OSC signal broad, as an optical signal, since no specific definition or function for the OSC signal is recited) in the form of IP datagrams (col. 4, lines 36-39) along two different optical paths (col. 4, lines 45-48, note that optical signal DS travel along the path 1.2 in a clockwise direction, and along the path 1.1 in a counter clockwise direction) to a destination network element (for example, node K_1, fig. 1); and at the destination network element (for example at node K_1), passing one of the duplicate IP datagrams into the destination network element for processing (col. 4, lines 48-57, col. 5, lines 4-43, note that optical signal DS enters node K_1 in a forward direction F along the path 1.1 and it can be processed in node K_1, as it is shown by F_D in fig. 1) and filtering out for disposal the other one (col. 4, lines 50-62, col. 5, lines 24-27, note that optical signal DS entering node K_1 in a backward direction B along the path 1.2, is dropped or filtered for disposal in the node K_1, as it is shown by B_D in fig. 1). As to claim 12, Van Defender further teaches a source proxy (col. 4, lines 32-34 and CK, fig. 1) for sending an OSC in the form of IP datagrams (col. 4, lines 34-39, note that optical signal DS considered as an OSC, since no specific definition or function for the OSC is recited) under the control of a management station (col. 8, lines 8-9, note that central node CK receives a signal, as it is shown by an arrow in fig. 1). As to claim 16, Van Defender teaches a destination proxy (for

example, node K_1 of fig. 1) to receive the duplicate OSC (note that node K_1 receives optical signal DS, both in a forward direction F and in a backward direction B).

Regarding claim 13, Van Defender teaches a destination proxy (for example, node K_1 of fig. 1) to receive the duplicate OSC (note that node K_1 receives optical signal DS, both in a forward direction F and in a backward direction B) and passing one of the duplicate IP datagrams into the destination network element for processing (note that optical signal DS enters node K_1 in a forward direction F along the path 1.1, where it can be processed in node K_1, as it is shown by F_D in fig. 1) and filtering out for disposal the other one (optical signal DS entering node K_1 in a backward direction B along the path 1.2, can be filtered for disposal in the node K_1, as it is shown by B_D in fig. 1).

Regarding claims 14 and 17, Van Defender teaches the network element comprises of a network node (col. 4, lines 39-41).

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1, 3, 6-10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Defender (US Patent No: 5,886,801) in view of Chawki et al. (US Patent No: 5,745,269).

Regarding claim 1, Van Defender teaches an optical network (fig. 1) that is comprised of a source network element (CK, fig. 1), a destination network element (K_1, fig. 1), wherein the source network element comprises of a source proxy (col. 8, line 8, the transmitter in the CK)

that sends duplicate IP data grams (the optical signal DS that is duplicated and transmitted in F and B directions) along two different paths (1.1, 1.2, fig. 1) to the destination network element (K_1, fig. 1 and 21, fig. 2), and wherein at the destination network element a destination proxy (28, 33, fig. 2) is arranged to pass one of the duplicate IP datagrams for processing (optical signal DS that enters node K_1 in a forward direction F, along the path 1.1 can be processed, as it is shown by F_D in fig. 1) and to filter out for disposal the other one (optical signal DS that enters node K_1 in a backward direction B along the path 1.2, can be filtered for disposal, as it is shown by B_D in fig. 1), as discussed above. Van Defender differs from the claimed invention in that Van Defender do not disclose a network management station. Chawki teaches an optical ring network (fig. 1) with a central station (T, fig. 1) and a plurality of secondary stations (S1, S2, S3, fig. 1), wherein the central station (T, fig. 1) manages the loop and each secondary station (col. 2, lines 22-25, 50-52). Therefore, it would have been obvious to an artisan at the time of invention that an optical central station and transmission means such as the one of Van Defender can have management means, as it is taught by Chawki, in order to establish the connection set-up and routing the traffic in the ring network.

Regarding claim 3, as to distribution of control messages, Van Defender teaches a central node CK that receives a signal, as it is shown by an arrow in fig. 1, and it would have been obvious that the central node CK can send control messages to the other nodes of the network, as discussed above in claim 1.

Regarding claim 6, Van Defender discloses the network element is a network node (col. 4, lines 47-49).

Regarding claim 7, Van Defender discloses the network is a ring network (fig. 1) and transmission paths are along opposite directions (1.1, 1.2, fig. 1).

Regarding claim 8, Van Defender discloses the network is a mesh network (fig. 1). Claim 8 further requires similar limitations as discussed above in claim 1.

Regarding claim 9, Van Defender discloses the optical network comprises more than one destination network elements (there are a plurality of other nodes such as K_N, K_i, fig. 1), wherein the OSC is terminated and re-transmitted at each destination network element (each destination node, such as nodes K_N and K_i can receive and re-transmit the OSC, or the optical DS signal, to other nodes).

Regarding claim 10, Van Defender discloses the destination proxy is arranged to be capable of functioning as a source proxy (note that in the ring network of Van Defender each node, or each destination proxy such as node K_1, receives optical signal DS in both direction and each node re-transmit, or function as a source proxy for transmitting optical signal to the next node).

Regarding claim 15, it requires similar limitations as discussed above in claim 1.

10. Applicant's arguments with respect to claims 1, 11, 12, and 16 have been considered but are moot in view of the new ground(s) of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. R. Sedighian whose telephone number is (703) 308-9063. The examiner can normally be reached on M-F (from 9 AM to 5 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Chan can be reached on (703) 305-4729. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

M. R. Sedighian

M.R. SEDIGHIAN
Patent Examiner
Art unit: 2633